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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,568	05/05/2006	Thomas Hasskerl	287554US0PCT	6924
22850	7590	06/18/2009	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			WALTERS JR, ROBERT S	
			ART UNIT	PAPER NUMBER
			1792	
			NOTIFICATION DATE	DELIVERY MODE
			06/18/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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## **ADVISORY ACTION**

### ***Status of Application***

Claim 28 is cancelled. Claims 1-27 and 29-40 are pending.

### ***Response to Arguments***

Applicant's arguments filed 6/11/2009 have been fully considered but they are not persuasive. The applicant has amended claim 1 to recite that the inert nanoparticles have a median primary particle size of from 2 to 100 nm. The examiner contends that while Hino fails to disclose this particular range (note Hino does teach a silica particle size of from 0.1 to 3 microns (100-3000 nanometers, see 0042)), it would have been obvious to one of ordinary skill in the art at the time of the invention to optimize the nanoparticles to have a median particle size in this range (in the absence of evidence to the contrary or a showing of criticality of this variable), as it would have been obvious to one of ordinary skill in the art at the time of the invention that the size of the nanoparticles would affect the quality of the coating, such as its conductivity and scratch resistance. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to choose the instantly claimed range through process optimization, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

The applicant argues that the references of record fail to teach or suggest the degree of aggregation. However, the examiner maintains that Hino's metal oxide particles either inherently

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have a degree of aggregation between 0.01 to 99% (as any amount of aggregation outside of full aggregation will almost necessarily fall within this range), based on aggregates comprising at least two primary particles, or that it would have been obvious to one of ordinary skill in the art at the time of the invention to adjust the degree of aggregation comprising two primary particles to be in this claimed range, through routine optimization. It would have been obvious to one of ordinary skill in the art at the time of the invention that the degree of aggregation of these primary particles would ultimately affect the antistatic properties of the hard coat as well as the transparency of the hard coat. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to optimize this degree of aggregation to provide metal oxide particles having a degree of aggregation from 0.01 to 99% based on aggregates which comprise at least two primary particles.

### *Status of Claims*

Claims 1-27 and 29-40 remain provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-40 of copending Application No. 10/548878 in view of Hino et al. (U.S. PG PUB No. 2003/0173545).

Claims 1-10, 12, 20, 27, 30, 31 and 33-36 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hino et al. (U.S. PG PUB No. 2003/0173545).

Claims 11 and 37-39 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hino in view of Yamaya et al. (U.S. PG PUB No. 2003/0087102).

Claims 13-19, 21-26 and 40 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hino in view of Servaty et al. (U.S. PGPUB No. 2003/0124051).

Claims 13-19, 21-26 and 40 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hino in view of Hasskerl et al. (WO 03/000808, referencing U.S. PGPUB No. 2004/0213989 as its English equivalent).

Claim 29 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Hino in view of Liu et al. (U.S. PGPUB No. 2002/0114934).

Claim 32 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Hino in view of Anand et al. (WO 95/10564).

### ***Conclusion***

Claims 1-27 and 29-40 are pending.

Claims 1-27 and 29-40 are rejected.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT S. WALTERS JR whose telephone number is (571)270-5351. The examiner can normally be reached on Monday-Friday, 8:00am to 5:00pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on (571)272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Barr/  
Supervisory Patent Examiner, Art Unit  
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/ROBERT S. WALTERS JR/  
June 15, 2009  
Examiner, Art Unit 1792